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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,382	09/30/2003	Corinne Bortolin	16222U-016700US	9159
66/945 7590 06/22/2009 TOWNSEND AND TOWNSEND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3688				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/676,382

Applicant(s)

BORTOLIN ET AL.

Examiner

DANIEL LASTRA

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 2-9 and 11-20 have been examined. Application 10/676,382 (SYSTEM AND APPARATUS FOR LINKING MULTIPLE REWARDS PROGRAMS TO PROMOTE THE PURCHASE OF SPECIFIC PRODUCT MIXES) has a filing date 09/30/2003.

Response to Amendment

2. In response to Non Final Rejection filed 11/17/2008, the Applicant filed an Amendment on 03/17/2009, which amended claims 2-9, 11-10 and cancel claims 1 and 10.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 19 is non-statutory because it is claiming two different statutory classes.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere, in Applicant's specification is recited the limitation "wherein the combination reward is the ability to access at least one of the first and second reward at an earlier time than one or more times associated with the at least one of the first and second rewards".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7 and 16 are indefinite because nowhere in Applicant's specification is recited "wherein the combination reward is the ability to access at least one of the first and second reward at an earlier time than one or more times associated with the at least one of the first and second rewards". For purpose of art rejection, said limitation would be interpreted as giving a consumer that purchase a first product from reward program A and also purchase a second product from reward program B the ability to access a "special program" earlier than consumers that have not satisfied the predetermined combination reward program reward triggers of purchasing said first and second product.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-5, 7-9, 11-14, 16 and 17-20 rejected under 35 U.S.C. 102(b) as being anticipated by Fowler (US 2002/0026348).

Claims 2 and 11, Fowler teaches:

(a) receiving information from a server computer about a first pre-existing reward program for a first product, wherein the first reward program provides for a first reward (see paragraphs 28-30);

(b) receiving information from the server computer about a second pre-existing reward program for a second product, wherein the second reward program provides a second reward (see paragraphs 28-30) ; and

(c) providing for a combination reward program that provides a combination reward that is based on at least the purchase of the first product and the second product, and wherein the combination reward is greater than each of the first reward and the second reward (see paragraphs 28-30).

(d) reducing or eliminating the combination reward, if a third product is purchased (see paragraph 30).

Claims 3 and 12, Fowler teaches:

receiving information about a third pre-existing reward program for a third product, wherein the third reward program provides a third reward, wherein the combination reward is greater than the third reward (see paragraph 30).

Claims 4 and 13, Fowler teaches:

wherein the combination reward program is provided by a host organization, and wherein the host organization also provides a portable consumer device, wherein the combination reward is provided to the consumer after the user uses the portable consumer device, and wherein (a), (b), and (c) are performed using one or more digital computers (see paragraphs 17-19 "host controller").

Claims 5 and 14, Fowler teaches:

wherein the combination reward program is provided by a host organization, and wherein the host organization also provides a portable consumer device, wherein the portable consumer device is a smart card (see paragraph 58, 83).

Claims 7 and 16, Fowler teaches:

(a) receiving information from a server computer about a first pre-existing reward program for a first product, wherein the first reward program provides for a first reward (see paragraphs 28-30);

(b) receiving information from the server computer about a second pre-existing reward program for a second product, wherein the second reward program provides a second reward (see paragraphs 28-30) ; and

(c) providing for a combination reward program that provides a combination reward that is based on at least the purchase of the first product and the second

product, and wherein the combination reward is greater than each of the first reward and the second reward (see paragraphs 28-30).

wherein the combination reward is the ability to access at least one of the first and second rewards at an earlier time than one or more times associated with the at least one of the first and second rewards (see figure 7 "you are the lucky winner of a trip for 2 to Hawaii"). Fowler teaches giving a consumer that participates in the Award accelerator program by purchasing a specific number of products from different merchants (see paragraph 28) the ability to access an Instant Win Program (see paragraph 87) earlier than consumers that has not participated in said Award Accelerator program.

Claims 8 and 17, Fowler teaches:

providing the combination reward to a customer (see paragraph 28).

Claims 9 and 18, Fowler teaches:

wherein the first reward program is created by a first merchant and wherein the second reward program is created by a second merchant (see paragraph 28-30, figure 4a-c), and

wherein the combination reward program is created by a host organization that is affiliated with the first merchant and the second merchant (see paragraph 17).

Claims 19 and 20, Fowler teaches:

Wherein the first product is purchased at a first location and the second product is purchased at a second location (see paragraph 31, 104).

6. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Ryan (US 2005/0055272).

Claims 6 and 15, Fowler does not expressly teach:

wherein the combination reward is an extension of time to receive at least one of the first reward and the second reward. However, Ryan teaches that it is old and well known in the promotion art to extend the expiration date of a reward (i.e. cash value coupon) when said reward is offered in combination with another reward (i.e. joint a private club as a reward) (see paragraph 52). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would offer coupon rewards with an extension of time, when said coupon rewards are offered with a combination of another product, as Ryan teaches that it is old and well known to do so.

Response to Arguments

7. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. With respect to claims 7 and 16, the Applicant argues that the limitation of "wherein the combination reward is the ability to access at least one of the first and second reward at an earlier time than one or more times associated with the at least one of the first and second rewards" means according to the Applicant, that a consumer that purchases both the first product and the second product may be given earlier access (e.g. 10 days earlier) to the first reward associated with the first product than the consumer that has purchased the first product and not the second product. The Examiner answers that the Applicant is adding new matter to the

Specification. Paragraph 63 of Applicant's specification (2005/0071225) (paragraph 68 of Application 10/676,382) recites that a consumer that participates in all programs (e.g. purchases the first product of reward program A, the second product of reward program B, third product of reward program 1 and the fourth product of reward program 2 would be granted access to a set of "special programs" 10 days earlier than consumers who has not satisfied the predetermined combination reward program reward triggers of purchasing said products from said reward programs. Nowhere, in Applicant's specification is recited that said earlier access to said set of "special program" means the ability to access at least one of first reward A, second reward B, third reward 1 or fourth reward 2 at an earlier time than one or more times associated with the at least one of the A, B, 1 and 2 rewards. Therefore, the limitation "wherein the combination reward is the ability to access at least one of the first and second reward at an earlier time than one or more times associated with the at least one of the first and second rewards" is interpreted in light of Applicant's specification as giving a consumer that participates in all programs by purchasing a first product from reward program A and purchasing a second product from reward program B the ability to access a "special program" earlier than consumers that have not satisfied the predetermined combination reward program reward triggers of purchasing said first and second product.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Examiner, Art Unit 3688
June 16, 2009